



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application:
Batten et al.

Serial No.: 10/099,823

Filed: February 13, 2002

For: RESISTIVE-HEATED COMPOSITE
STRUCTURAL MEMBERS AND
METHODS AND APPARATUS FOR
MAKING THE SAME

Confirmation No.: 2707

Group Art Unit: 1732

Examiner: Vargot, Mathieu D.

Mail Stop Non-Final Response
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed November 18, 2003, Applicant requests reconsideration of the restriction requirement in light of the following remarks.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:
Commissioner for Patents, P.O. Box 1450 Alexandria,
VA 22313-1450, on this 18th Day of December, 2003.

Signed: Margaret Carlson

The Restriction Requirement

The Office has required restriction to one of the following groups of inventions under 35 U.S.C. § 121:

Group I: claims 1-10, 14-23, and 27-34, drawn to a method and apparatus for making/heating a composite material, classified in class 264, subclass 450; and

Group II: claims 11-13 and 24-26, drawn to a composite material, classified in class 428, subclass 292.1.

The Office argues that Groups I and II are related as a process of making and product made. The Office contends that the inventions of these two groups are distinct since the product as claimed can be made by another and materially different process and apparatus such as one where a current is not caused to flow through the composite, which would then be heated thermally instead of electrically. The Office concludes that because the groups of inventions are distinct for these reasons, and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes is proper.

Applicant elects with traverse to prosecute the invention of Group I, claims 1-10, 14-23, and 27-34. Applicant does NOT traverse the Office's classification of the groups of inventions as distinct and entailing different patentability determinations, merely the reasoning behind the Office's classification.

The Manual of Patent Examining Procedure (M.P.E.P.) sets forth those instances where the Office can impose a restriction requirement. As set forth in the first paragraph of M.P.E.P. §

803, the Office can impose a restriction requirement where the inventions are independent or distinct. The next paragraph, however, creates an exception.

If the search and examination of an entire application can be made without serious burden, the examiner **must** examine it on the merits, **even though it includes claims to independent or distinct inventions.**

M.P.E.P. § 803 ¶ 2 (emphasis added).

The present application falls within this exception. The Office has already searched and examined the entire application on the merits by issuing the Office Action dated June 4, 2003. Thus, there exists no serious burden for the Office to search and examine the entire application because the Office has already taken such an action. Since there exists no serious burden, the Office “must” examine the “entire” application and cannot require restriction. The Office’s assertion that the product as claimed can be made by another and materially different process and apparatus is irrelevant because it no longer matters whether the claims of Group I and Group II are distinct and/or independent.

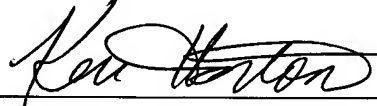
Thus, the Office has not established a proper restriction requirement between Groups I and II. Accordingly, Applicant respectfully requests withdrawal of this restriction requirement and examination of all pending claims.

CONCLUSION

For the above reasons, Applicant respectfully requests the Office to withdraw the restriction requirement and examine all the pending claims.

If there is any fee due in connection with the filing of this Request, including a fee for any extension of time not accounted for above, please charge the fee to our Deposit Account No. 50-0843.

Respectfully Submitted,

By 
KENNETH E. HORTON
Reg. No. 39,481

Date: December 18, 2003